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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/757,333	01/14/2004	Isaac Algaze	450-001	3460

7590 04/22/2005

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EXAMINER

EDWARDS, LAURA ESTELLE

ART UNIT	PAPER NUMBER
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1734

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/757,333

Applicant(s)

ALGAZE, ISAAC

Examiner

Laura Edwards

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 011404.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7, drawn to an apparatus, classified in class 118, subclass 264.
- II. Claim 8*, drawn to a method, classified in class 427, subclass 429.

*The Examiner notes that the method claim was not numbered but has been treated claim 8 as the next number in sequence.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used for a materially different process such as applying fingernail polish remover.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with Mr. Barman on 3/31/05 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-7. Affirmation of this election must be made by applicant in replying to this Office action. Claim 8 is withdrawn from

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further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Morehouse (US 1,978,716).

Morehouse teaches a lubricating device comprising a holder (12, 12') and an insert (22, 22') for receipt in the holder wherein the insert forms a receiving cavity with an adjacent insert.

With respect to claims 3-5, see page 1, line 105-109.

Claims 1 and 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown (US 2,413,682).

Brown teaches an apparatus for lubricating a comb comprising a holder (10) and an insert (11) for receipt in the holder wherein the insert forms a receiving cavity for lubricating the comb via use of absorbent or fabric strips (12).

With respect to claims 3-5, see col. 1, line 47-49.

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Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Baxter (US 3,491,854).

Baxter teaches an apparatus for lubricating a zipper or other type of fastener comprising a holder (63, 64) and an insert (62) for receipt in the holder wherein the insert forms a receiving cavity between opposed sides of the holder for lubricating the zipper via use of absorbent material or felt.

With respect to claims 3-5, see col. 3, lines 9-14.

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Montiel (US 4,530,726).

Montiel teaches an apparatus for applying a fingertip treating liquid including castor oil to nails comprising an insert (16) having slits (20) for forming a fingernail receiving cavity and a holder (12) for receiving the insert.

With respect to claims 3 and 4, see col. 3, lines 30-36.

With respect to claims 6 and 7, the insert is separated manually via insertion of a fingertip in the apparatus.

Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Buckelew (US 5,022,493).

Buckelew teaches an apparatus for applying lubricant to cables comprising a holder (40) and an insert (70) for receipt in the holder wherein the insert forms a receiving cavity with an adjacent insert (see Fig. 5).

With respect to claims 3 and 4, see col. 2, lines 54-57 wherein open celled sponge material can be used which includes sponge made from polymer foams.

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Majerowicz et al (US 5,293,960).

Majerowicz et al teach a button lubricating apparatus comprising a polyurethane foam insert (16) having slits (13) for forming a receiving cavity and a holder (22) for receiving the insert.

With respect to claims 3 and 4, see col. 1, lines 42-47.

With respect to claims 6 and 7, the insert is separated when the article to be lubricated is inserted in the slit area. Further separation of the insert results when the lid (20) of the container presses the article in the apparatus.

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Parnell (US 5,743,359).

Parnell teaches a bolt lubricating apparatus comprising a poly-foam insert (16; col. 2, lines 53-56) having slits (18) for forming a receiving cavity and a holder (14) for receiving the insert.

With respect to claims 6 and 7, the insert is separated when the article to be lubricated is manually inserted by the user in the slit area.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Morehouse (US 1,978,716).

The teachings of Morehouse have been mentioned above but Morehouse is silent concerning the use of the apparatus for lubricating a sliding glass door track, window track, zipper or fastener. While the intended use of the apparatus does not invoke a structural limitation in an apparatus claim, even upon consideration of the claimed limitation, one of ordinary skill in the art would expect that the Morehouse apparatus would be used to lubricate any surface capable of fitting within the receiving cavity defined by the holder. It is within the purview of one skilled in the art to use the apparatus to lubricate any surface in so long as said surface fits within the receiving cavity.

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Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Buckelew (US 5,022,493).

The teachings of Buckelew have been mentioned above but Buckelew is silent concerning the use of the apparatus for lubricating a sliding glass door track, window track, zipper or fastener. While the intended use of the apparatus does not invoke a structural limitation within the meaning of an apparatus claim, even if one gave the limitation consideration, one of ordinary skill in the art would expect that the Buckelew apparatus would be used to lubricate any surface area capable of fitting within the receiving cavity defined by the holder. It is within the purview of one skilled in the art to use the apparatus to lubricate any surface in so long as said surface fits within the receiving cavity.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Parnell (US 5,743,359).

The teachings of Parnell have been mentioned above but Parnell is silent concerning the use of the apparatus for lubricating a sliding glass door track, window track, zipper or fastener. While the intended use of the apparatus does not invoke a structural limitation within the meaning of an apparatus claim, even if one gave the limitation consideration, one of ordinary skill in the art would expect that the Parnell apparatus would be used to lubricate any surface area capable of fitting within the receiving cavity defined by the holder. It is within the purview of one skilled in the art to use the apparatus to lubricate any surface in so long as said surface fits within the receiving cavity.

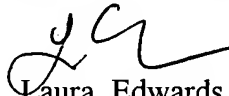
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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura Edwards whose telephone number is (571) 272-1227. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Laura Edwards
Primary Examiner
Art Unit 1734

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April 20, 2005